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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,979	10/09/2003	Carl Joseph Thaemlitz	HALB:023D1	7801

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EXAMINER	
TUCKER, PHILIP C	

ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/681,979	THAEMLITZ, CARL JOSEPH	
	Examiner	Art Unit	
	Philip C. Tucker	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13-20,26-34,36-38 and 40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *27-34* is/are allowed.

6)☒ Claim(s) *13-20,26,36,38 and 40* is/are rejected.

7)☒ Claim(s) *37* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 20 is objected to because of the following informalities: Claim 20 uses, "selected from the group comprising" to describe a Markush group. Since the word "comprising" would include other compounds than those listed, such is improper. Proper Markush language such as "selected from the group consisting of" should be used. Appropriate correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims13-19, 36, 38 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Mueller (6022833).

Mueller teaches an invert emulsion fluid which comprises an ester as the continuous phase, a sorbitan monolaurate ester surfactant, a polyoxyethylene

glycerolmonococoate surfactant, and calcium chloride brine as internal phase (see example 7). A fluid loss additive may also be present (see claim 19). Such would inherently possess micelles having a denser concentration in the palisade layer, than that of the emulsion containing either surfactant alone. With respect to claim 38, it is well established that a product by process claim is not distinguished by the product being made by a different process (In re Thorpe 227 USPQ 964).

3. Claims 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Reifschneider (4729987).

Reifschneider teaches a fluid which comprises acetone, sorbitan trioleate and polyoxyethylene sorbitan monolaurate (see example 6). Such would inherently possess micelles having a denser concentration in the palisade layer, than that of the emulsion containing either surfactant alone, and the specified electrical conductivity effects. Applicants intended use as a drilling fluid does not distinguish (In re Pearson 181 USPQ 641).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 13, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller (6022833).

Mueller is taught above. Mueller differs from the present invention in teaching the specified fluid loss control additives of claim 20. However, such additives, especially calcium carbonate are notoriously well known as fluid loss additives in well fluids, and their use would be obvious to one of ordinary skill in the art, over the general teaching of fluid loss additives in claim 19 of Mueller.

6. Claims 13-16, 26, 38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tadros (4875927).

Tadros teaches an invert emulsion fluid which can comprise vegetable oils as the continuous phase (see column 2, lines 41-46). Such vegetable oils comprise ester oils therein. The emulsifier may comprise a mixture of SPAN and TWEEN (trademarks), which are sorbitan esters and ethoxylated sorbitan esters, respectively (column 3, lines 34-36). Tadros differs from the present invention in that a specific example of the mixture of vegetable oils and SPAN and TWEEN is not exemplified, and the percentage of the oil phase is not specified. It would however be obvious to one of ordinary skill in the art to utilize a combination of vegetable oil with SPAN and TWEEN, given the teaching of Tadros that such is useful for making the invert emulsion therein. Such would obviously possess the same properties as the composition of the present claims. The variation of the amount of oil in the invert emulsion to obtain optimum properties therein, would be an obvious variation to one of ordinary skill in the art. Applicants

intended use as a drilling fluid does not distinguish (In re Pearson 181 USPQ 641). With respect to claim 38, it is well established that a product by process claim is not distinguished by the product being made by a different process (In re Thorpe 227 USPQ 964).

7. Claims 27-34 are allowable over the art of record.

8. Claim 37 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Applicant's arguments have been considered but are not deemed fully persuasive. Applicant's amendment to claim 38 to include a polar ester in the oil base distinguishes over Walker, Reifschneider and WO '840 which fail to teach or sufficiently suggest the use of such polar ester base oil in the specified compositions. With respect to Mueller, such teaches the use of similar ester and ethoxylated ester surfactants as in the present invention. Such similar surfactants would be expected to behave in the same manner as those of the present invention, absent a showing of the applicant to the contrary. Applicant has not given any evidence that such similar compositions would act differently, and thus the rejection is maintained. With respect to the rejection under 35 USC 103(a) over Mueller, applicant has questioned whether calcium

carbonate is known as a fluid loss agent. Such is so well known that one of marginal skill in the art of drilling fluids would have such knowledge. Official Notice is taken of patents US 5504062, 5680900, 5881813 and 5981447 which all teach the use of calcium carbonate as a fluid loss agent.

With respect to Reifschneider, such teaches the use of similar ester and ethoxylated ester surfactants as in the present invention. Such similar surfactants would be expected to behave in the same manner as those of the present invention, absent a showing of the applicant to the contrary. Applicant has not given any evidence that such similar compositions would act differently, and thus the rejection is maintained.

With respect to Tadros, such is analogous prior, being in the same art of invert emulsions. One of ordinary skill in the art of invert emulsions would look to varying areas of invert emulsions in order to formulate such invert emulsion.

With respect to applicants general arguments, a novel intended use, or the discovery of an old or obvious property of a composition is not a patentable distinction (In re Pearson 181 USPQ 641, In re Tuominen 213 USPQ 89, In re Tomlinsin 150 USPQ 623, In re Dillon 16 USPQ2d 1897).

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C. Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Philip C Tucker

Primary Examiner
Art Unit 1712

PCT-3909